

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHELLE Q. WANG BALDONADO, STEVE B. COUSINS,
POLLE T. ZELLWEGER, ANDREAS PAEPCKE,
and JACEK S. GWIZDKA

Appeal 2007-0276
Application 09/461,040
Technology Center 2100

Decided: April 11, 2007

Before KENNETH W. HAIRSTON, ALLEN R. MACDONALD, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-37, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Appellants invented a system for generating annotations and associating the annotations with objects (e.g., media-type objects). A viewing device enables the user to view the object. Additionally, an annotation device -- distinct from the viewing device -- enables the user to enter annotations corresponding to the object. The annotations are stored in a database along with the object identifier and a link associating the annotation and the object. By providing distinct viewing and annotation devices, annotations can be made while viewing the object on a device separate from the annotation device. *See generally* Specification 1-4. Claim 1 is illustrative:

1. An annotation system that associates annotations with at least one object, the annotation system comprising:
 - a viewing device for viewing the at least one object, the viewing device being distinct from an annotation device;
 - a search circuit that locates the at least one object to be annotated and provides an object identifier that corresponds to the at least one object;
 - the annotation device allowing a user to make at least one annotation independently from the at least one object, the annotation device comprising:
 - an input device that inputs the at least one annotation;
 - an annotation linking circuit that establishes a link associating the at least one annotation with at least one portion of the object;
 - a database that stores the object identifier, the at least one annotation and the link; and
 - a synchronize circuit that associates the at least one annotation with the at least one portion of the object based on the link and the object identifier, ; [sic] and
 - wherein the user makes annotation using the annotation device while viewing the at least one object using the distinct viewing device, and upon synchronization by the synchronize circuit, the at least one annotation is transferred to the at least one object.

The Examiner relies on the following prior art references to show unpatentability:

Eberman	US 6,173,287 B1	Jan. 9, 2001 (filed Mar. 11, 1998)
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Bill N. Schilit et al., *Beyond Paper: Supporting Active Reading With Free Form Digital Ink Annotations*, CHI 98, Los Angeles CA, pp. 249-56, Apr. 1998 ("Schilit").

The Examiner's rejection is as follows:

Claims 1-37 are rejected under 35 U.S.C. § 103(a) as unpatentable over Eberman in view of Schilit.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual

determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). If that burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding the independent claims, the Examiner's rejection essentially finds that Eberman teaches a system and method for associating annotations with at least one object with every claimed feature except for a viewing device that is distinct from the annotation device. The Examiner cites Schilit as teaching this feature and concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a distinct viewing device in Eberman's system to monitor free-form ink annotations made while reading (Answer 3-6, 8, 10-11).

Regarding independent claim 1, Appellants argue that Schilit does not teach or suggest a viewing device that is distinct from the annotation device as claimed. According to Appellants, Schilit's viewing device and annotation device are one and the same device (Br. 8). Appellants contend that Schilit teaches concurrently displaying and annotating the document on the tablet; therefore, the viewing and annotation devices are not distinct devices (Br. 10).

Appellants further argue that because Schilit's system is designed to enable the user to annotate documents directly on the tablet that displays the document, it cannot incorporate the object database 120 of Eberman. Appellants contend that there is no motivation to combine the annotation ranking features of Eberman with Schilit's tablet since Schilit teaches away

from multimedia networked document retrieval and annotation (Br. 11). The Examiner notes that Schilit's tablet can function both as a standalone device, and a tablet display connected to a computer (Answer 11-12, 14).

We will sustain the Examiner's rejection of independent claim 1. We agree with the Examiner that Schilit would have suggested providing a viewing device that is distinct from an annotation device as claimed. As the Examiner indicates, Schilit's tablet can function both as (1) a standalone device, and a (2) tablet display connected to a computer. *See* Schilit, p. 252, col. 1, ¶ 1.

Although we agree with Appellants that Schilit's *standalone* annotation device does not itself provide a viewing device distinct from the annotation device as claimed, the second option (i.e., the tablet display connected to a computer) does in fact suggest distinct viewing and annotation devices. In this mode, the computer constitutes the "viewing device" and the tablet constitutes the "annotation device."

Significantly, Schilit states "we envision our active reading machine coexisting with personal computers and with paper, and we see *documents moving freely between these three media*. In our current system, *readers can 'print' from their desktop computer into XLibris* and can scan paper documents into XLibris..." (Schilit, p. 253, col. 1, ¶ 2; emphasis added).

"Printing" a document from a desktop computer into the annotation device would effectively create two versions of the document: (1) a version on the computer, and (2) a version on the tablet. Thus, the user could view the document on the computer's monitor and annotate the document using the tablet.

On this record, we see no reason why the skilled artisan would not have utilized commensurate functionality in the system of Eberman. In Eberman, object annotations are generated either automatically or by trusted human annotators (Eberman, col. 15, ll. 4-11). *See also* Eberman, col. 20, ll. 21-32 (“From the point of view of the librarian 28, a human sitting at an annotation station is just another requesting annotation client 18.”). In view of the collective teachings of Eberman and Schilit, the skilled artisan would have recognized that an annotator in Eberman would have the capability to annotate objects using a networked computer in concert with a distinct annotation device. Such a capability would, at a minimum, provide added flexibility to the user in entering and reviewing the object annotations.

In short, we find ample motivation on this record to combine the references given the general knowledge of skilled artisans -- electrical engineers with several years of related industry experience. It is well settled that a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (internal citations omitted).

For at least these reasons, we will sustain the Examiner’s rejection of independent claim 1. Since Appellants have not separately argued the patentability of dependent claims 2-13, these claims fall with independent

claim 1. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding independent claims 14 and 26, Appellants reiterate that Schilit teaches that the viewing and annotation devices are one and the same device -- not distinct viewing and annotation devices as claimed (Br. 12-13). But for at least the reasons previously discussed, however, we find that Schilit suggests distinct viewing and annotation devices. Moreover, we conclude that there is ample motivation to combine Schilit with Eberman for the reasons previously discussed.

The Examiner's rejection of independent claims 14 and 26 is therefore sustained. Since Appellants have not separately argued the patentability of dependent claims 15-25 and 27-37, the Examiner's rejection of those claims is likewise sustained. *See* 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

We have sustained the Examiner's rejection with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 1-37 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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